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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,874	03/18/2004	Hideo Matsunaga	Q80281	5453

23373 7590 11/01/2005  
SUGHRUE MION, PLLC  
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EXAMINER

PASSANITI, SEBASTIANO

ART UNIT PAPER NUMBER

3711

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

*TALH*

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/802,874	MATSUNAGA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Sebastiano Passaniti	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

This Office action is responsive to communication received 08/16/2005 –  
Amendment; 09/23/2005 – IDS.

Claims 1-12 remain pending.

Following is an action on the MERITS:

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all  
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 STAND rejected under 35 U.S.C. 103(a) as being unpatentable over  
Tsuchiya ('217) in view of Motomiya ('931), Hoshi ('560) and Tsuchida ('913), as set  
forth in the last Office action, mailed 05/16/2005.

#### ***Comments on Double Patenting***

Applicant is once again respectfully reminded to maintain a clear line of  
demarcation between the limitations in the instant claims and the claims of the  
copending application serial no. 10/188,043 in order to avoid the need to address any  
instance of double patenting or obviousness-type double patenting throughout the  
remainder of prosecution of the instant application.

### **RESPONSE TO ARGUMENTS**

In the arguments received 08/16/2005, the applicant contends that a *prima facie*  
case of obviousness has not been established through the combined teachings of

Tsuchiya *et al*, Tsuchida and Hoshi. Rather than reiterate the arguments presented by the applicant, attention is drawn to the remarks received 08/16/2005, incorporated herein by reference. The basis for the arguments set forth by the applicant rely on the alleged non-obviousness of modifying the prior art device shown in Tsuchiya *et al* when considering the teachings of Tsuchida, given that Tsuchida teaches away from having a hollow core design. Moreover, the applicant argues that the prior art to Hoshi teaches the use of the same Young's modulus for all parts of the head and further contends that there is no basis supplied by the Office for the obviousness-type rejection against the claimed club head body having the specific claimed dimensions and/or properties.

In response to these arguments, it is noted that careful consideration has been given to applicant's arguments, but the rejections set forth in the last Office action are still deemed proper. True, the prior art reference to Tsuchida discloses a golf club head with a core construction. In other words, the design of the Tsuchida golf club head does not lend itself to a hollow style construction. However, the rejection of claims 1-12 is based upon a modification of the Tsuchiya ('217) reference in view of Tsuchida ('913), Motomiya ('931) and Hoshi ('560). The rejection is not based upon Tsuchida ('913) in view of Tsuchiya ('217). The patent to Tsuchiya shows every feature claimed with the exception of a crown and side portion each having a Young's modulus lower than the face and sole portions, a rib on the sole portion and the specific claimed Young's modulus values. Tsuchida is cited to show that it is old in the art to provide a golf club head with a top portion that exhibits a lower modulus than the remainder of the shell. More specifically, the crown portion (5) is made of a first material with a modulus of 210

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GPA, while the remainder of the shell is made of a material having a modulus of between 150-250 GPA (col. 6, lines 44-57). Thus, in view of the patent to Tsuchida, it would have been obvious to modify the device in the Tsuchiya device by fabricating the crown portion from a material that is diverse from the material of the remaining shell members, the motivation being to provide another means for increasing the flexure of the crown on impact of a golf ball with the clubface, the flexure creating improved flight of the struck ball, all as set forth in the last Office action.

With respect to the teachings supplied by the prior art to Hoshi, while the Hoshi reference may disclose that the Young's modulus is uniform throughout the head, there is nonetheless a clear teaching in Hoshi that the material selected for the head is dependent upon consideration of a particular Young's modulus. A distinct relationship has nonetheless been acknowledged among the desired Young's modulus, the thickness of the crown and the material chosen. Once again, the applicant has not invented the claimed materials having the claimed Young's modulus values, but has merely selected materials exhibiting a Young's modulus that is optimally compatible with the particular thickness of the shell. Thus, the specific claimed values will not be considered critical. There is no need to provide any further evidence to support the obvious nature of the proposed rejection.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Monday through Friday (6:30AM - 3:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene L. Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S.Passaniti/sp  
October 28, 2005

  
**Sebastiano Passaniti**  
Primary Examiner